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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/759,108 12/02/96 QIN

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EXAMINER

REDDICK, M

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

05/01/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/759,108

Applicant(s)

QIN ET AL

Examiner

Judy M. Reddick

Group Art Unit

1713



☒ Responsive to communication(s) filed on Jan 15, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, and 4-34 is/are pending in the application.

Of the above, claim(s) 17-32 and 34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-16, and 33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. *Applicant should note and clarify, using cautionary measures, the following discrepancies appearing in the claims:*

In claims 1 a), 2 10, 11, 13, 16 and 33 a), the qualifying term "about" should be inserted before the upper limit. Instead of having removed the entire phrase "to about" in lieu of "and" only the "to" should have been removed so as to avoid any issues of indefiniteness. The Examiner apologizes for misleading applicant.

In claim 7, the term "starchs"(both occurrences) should read "starches".

2. *Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The recited "and copolymers thereof" per claim 7 constitutes indefinite subject matter as per it not being readily ascertainable as to exactly what is being referred to. For example, does applicant intend copolymers of each of the components with each other or other unrecited components.

3. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

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A person shall be entitled to a patent unless --

4. *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*
5. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. *Claims 1, 2, 4-16 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chmelir '471 or Mima et al (U.S. 3,962,158).*

Chmelir discloses and exemplifies absorbent compositions defined basically as containing A) a x-linked, partially neutralized(to the extent of 45%), water-swellaable polymer which includes polymers of (meth)acrylic acid, etc. and comfortably meets the component a) per claim 1 and B)a natural or synthetic compound such as salts of (in)organic acids, chitin-containing flour, etc. and

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comfortably meets the component b) per claim 1. See, e.g., the Abstract, col. 2, lines 35-68, cols. 3-6 and Run 1 of Chmelir. Chmelir therefore anticipates the instantly claimed invention. It is the base presumption that the claimed Free Swell value and the Time to Reach Free Swell capacity value may be met by Chmelir since the composition of Chmelir is essentially the same as and made in essentially the same way as applicant's composition. The burden is shifted to applicant to show that this, in fact, is not the case as per In re Best et al (195 USPQ 430).

Mima et al disclose and exemplify compositions defined basically as containing an alkali treated film of an admixture of a χ -linked, modified polyvinyl alcohol + a chitosan salt and comfortably meets the composition per claim 1 a) and b). See, e.g., the Abstract, cols. 2-3 and the Runs of Mima et al. Mima et al therefore anticipate the claimed invention. It is the base presumption that the Free Swell properties per the instant claims may be met by the composition of Mima et al since it is essentially the same as the claimed composition. The onus to show that this is not the case is shifted to applicant as per In re Best et al (195 USPQ 430).

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7. *Note the attached FORM PTOL-892 for additional prior art cited as of being illustrative of the general state of the art.*
8. *Applicant's election of the Group I/polyacrylic acid/chitosan invention in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).*
9. *Applicant's arguments filed January 15, 1998 have been fully considered but they are not persuasive.*

The crux of applicant's arguments appears to hinge on the neutralization of the prepared polymers prior to the mixture with the second component per the system of Chmelir.

The exemplified polymer of Chmelir is neutralized to the extent of 45% which corresponds to 55 % of Free Acid per Runs 1 and 2 and to this end, it is not understood how the time of neutralization has anything to do with the final composition, i.e., exactly how the composition of Chmelir differentiates over the

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claimed composition and there is absolutely nothing concrete on this record diffusing this issue.

JMR JMR

04/25/98

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